

ESTTA Tracking number: **ESTTA750204**

Filing date: **06/03/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Johnson & Johnson
Granted to Date of previous extension	08/31/2016
Address	One Johnson & Johnson Plaza New Brunswick, NJ 08933-7001 UNITED STATES
Attorney information	James D. Weinberger Fross Zelnick Lehrman & Zissu, P.C. 866 United Nations Plaza 6th Floor New York, NY 10017 UNITED STATES jweinberger@fzlz.com, lkittay@fzlz.com Phone:(212) 813-5900

Applicant Information

Application No	79176138	Publication date	05/03/2016
Opposition Filing Date	06/03/2016	Opposition Period Ends	08/31/2016
International Registration No.	1273214	International Registration Date	07/17/2015
Applicant	Obshchestvo s ogranichennoy otvetstvennostyu "Zeldis" dom 1, ul. Komsomolskaya, RUSSIAN FEDERATION		

Goods/Services Affected by Opposition

Class 003. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Cosmetics; hair lotions; balms other than for medical purposes, namely, lip balm, shaving balm, body balm; beauty masks; cleansing milk for toilet purposes; cosmetic creams; cosmetic kits comprised of lipsticks, make-up, deodorants for human beings, perfumery, cosmetic pencils, cosmetic creams, nail polish, hair spray, lotions for cosmetic purposes, cotton sticks for cosmetic purposes, douching preparations for personal, sanitary or deodorant purposes, make-up removing preparations, make-up powder, tissues impregnated with cosmetic lotions, eyebrow cosmetics, and cosmetic preparations for eyelashes; cosmetic preparations for baths; cosmetic preparations for skin care; creams for leather; dry shampoos; greases for cosmetic purposes; lacquer-removing preparations; lipsticks; massage gels other than for medical purposes; nail care preparations; oils for cosmetic purposes; pomades for cosmetic purposes; shampoos; soap; non-medicated toiletries

Class 005. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Albumin dietary supplements; alginate dietary supplements; casein dietary supplements; dietary supplements for animals; enzyme dietary sup-

plements; glucose dietary supplements; lecithin dietary supplements; linseed dietary supplements; linseed oil dietary supplements; mineral food supplements; nutritional supplements; pollen dietary supplements; propolis dietary supplements; protein dietary supplements; royal jelly dietary supplements; wheat germ dietary supplements


Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	506671	Application Date	09/23/1947
Registration Date	02/15/1949	Foreign Priority Date	NONE
Word Mark	LUBRIDERM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1946/03/01 First Use In Commerce: 1946/03/31 MEDICINAL SKIN LOTIONS		

U.S. Registration No.	1951779	Application Date	12/03/1993
Registration Date	01/23/1996	Foreign Priority Date	NONE
Word Mark	LUBRIDERM SERIOUSLY SENSITIVE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1994/05/10 First Use In Commerce: 1994/05/10 hand and body lotion		

U.S. Registration No.	3890927	Application Date	07/22/2009
Registration Date	12/14/2010	Foreign Priority Date	NONE
Word Mark	LUBRIDERM		
Design Mark			

Description of Mark	The mark consists of stylized word "LUBRIDERM".
Goods/Services	Class 003. First use: First Use: 2009/12/00 First Use In Commerce: 2009/12/00 body lotions and body creams

U.S. Registration No.	4009242	Application Date	01/07/2011
Registration Date	08/09/2011	Foreign Priority Date	NONE

Word Mark	LUBRIDERM
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 003. First use: First Use: 1946/03/31 First Use In Commerce: 1946/03/31 body and hand lotions; body and hand creams
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Attachments	77786575#TMSN.png(bytes) 85212488#TMSN.png(bytes) Notice of Opposition LIBREDERM.PDF(44929 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/s/ James D. Weinberger
Name	James D. Weinberger
Date	06/03/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 79/176,138
Published in the *Official Gazette* on May 3, 2016
Mark: LIBREDERM

JOHNSON & JOHNSON,

Opposer,

-against-

OBSHCHESTVO S OGRANICHENNOY
OTVETSTVENNOSTYU “ZELDIS,”

Applicant.

NOTICE OF OPPOSITION

Opposer, Johnson & Johnson, a corporation existing under the laws of New Jersey and having an office and principal place of business at One Johnson & Johnson Plaza, New Brunswick, New Jersey 08933 (“Opposer”), believes that it would be damaged by the registration of the trademark LIBREDERM applied for in Application Serial No. 79/176,138, filed on July 17, 2015, for goods in International Classes 3 and 5 by Obshchestvo s ogranichennoy otvetstvennostyu “Zeldis” (“Applicant”). As grounds for the opposition, Opposer alleges as follows:

1. Opposer has for many years been engaged in the manufacture, distribution, marketing and sale of a wide variety of pharmaceutical and personal care products.
2. Opposer’s LUBRIDERM® brand product line dates back to 1946 and is among the most popular brands of skin lotion. Opposer and its predecessor-in-interest has used the LUBRIDERM® mark and LUBRIDERM® inclusive marks (collectively, the “LUBRIDERM

Mark”) for many years in connection with the above goods and other goods and services, with hundreds of millions of dollars in annual sales. The product line is also promoted extensively, with a substantial amount of money spent on advertising annually.

3. As a result of its reputation, use and substantial sales success, and Opposer’s significant investment in advertising, LUBRIDERM has become a strong trademark identifying Opposer’s products exclusively. As such, the LUBRIDERM Mark represents an enormous goodwill and is an extremely valuable asset of Opposer.

4. Opposer is the owner of all right, title, and interest in and to the LUBRIDERM Mark in connection with skin lotions and creams based on first use in commerce as early as 1946. Additionally, Opposer owns numerous U.S. trademark registrations for the LUBRIDERM Mark for skin lotions and creams, including, but not limited to, the following:

- LUBRIDERM, U.S. Reg. No. 506,671, registered February 15, 1949 based on first use in interstate commerce on March 31, 1946, for “medicinal skin lotions” in International Class 5;
- LUBRIDERM SERIOUSLY SENSITIVE, U.S. Reg. No. 1,951,779, registered January 23, 1996 based on first use in interstate commerce on May 10, 1994, for “hand and body lotion” in International Class 3;
- LUBRIDERM and the following design:

The image shows the Lubriderm logo, which consists of the word "Lubriderm" in a bold, sans-serif font. The letter "L" is significantly larger and more prominent than the other letters, which are in a standard weight. The logo is centered horizontally.

U.S. Reg. No. 3,890,927, registered December 14, 2010 based on first use in interstate commerce in December 2009, for “body lotions and body creams” in International Class 3.

- LUBRIDERM, U.S. Reg. No. 4,009,242, registered August 9, 2011 based on first use in interstate commerce on March 31, 1946, for “body and hand lotions; body and hand creams” in International Class 3;

All of the registrations for the LUBRIDERM Mark relied upon herein are valid, subsisting and in full effect and serve as prima facie evidence of the validity of the mark and of Opposer’s exclusive right to use the LUBRIDERM Mark in connection with the goods identified therein, pursuant to Section 33(b) of the Lanham Act, 15 U.S.C. § 1115(a). Additionally, three of the above-referenced registrations (Reg. Nos. 506,671, 1,674,740 and 1,951,779) have become incontestable under Section 15 of the Lanham Act, 15 U.S.C. § 1065, and a Section 15 declaration has been filed for Reg. No. 3,890,927.

5. Upon information and belief, Applicant is a limited liability company organized under the laws of the Russian Federation and located and doing business at dom 1, ul. Komsomolskaya, g. Podolsk RU-142100 Moskovskaya obl., Russian Federation.

6. On July 17, 2015, Applicant filed Application Serial No. 79/176,138 to register the mark LIBREDERM for “Cosmetics; hair lotions; balms other than for medical purposes, namely, lip balm, shaving balm, body balm; beauty masks; cleansing milk for toilet purposes; cosmetic creams; cosmetic kits comprised of lipsticks, make-up, deodorants for human beings, perfumery, cosmetic pencils, cosmetic creams, nail polish, hair spray, lotions for cosmetic purposes, cotton sticks for cosmetic purposes, douching preparations for personal, sanitary or deodorant purposes, make-up removing preparations, make-up powder, tissues impregnated with cosmetic lotions, eyebrow cosmetics, and cosmetic preparations for eyelashes; cosmetic preparations for baths; cosmetic preparations for skin care; creams for leather; dry shampoos; greases for cosmetic purposes; lacquer-removing preparations; lipsticks; massage gels other than

for medical purposes; nail care preparations; oils for cosmetic purposes; pomades for cosmetic purposes; shampoos; soap; non-medicated toiletries” in International Class 3 and “Albumin dietary supplements; alginate dietary supplements; casein dietary supplements; dietary supplements for animals; enzyme dietary supplements; glucose dietary supplements; lecithin dietary supplements; linseed dietary supplements; linseed oil dietary supplements; mineral food supplements; nutritional supplements; pollen dietary supplements; propolis dietary supplements; protein dietary supplements; royal jelly dietary supplements; wheat germ dietary supplements “ in International Class 5 pursuant to Section 66A of the Lanham Act, 15 U.S.C. § 1141(f).

7. Upon information and belief, Applicant has not used the LIBREDERM Mark in commerce in the United States.

8. The LUBRIDERM Mark has been used continuously and/or registered by Opposer since a date prior to any date on which Applicant can rely.

9. Upon information and belief, prior to any date on which Applicant can rely, Applicant was on actual notice of Opposer’s prior rights in and to the LUBRIDERM Mark.

10. The priority date in Applicant’s application, July 10, 2015, which is the earliest date upon which Applicant can rely, is decades after the use, registration and acquisition of rights in the LUBRIDERM Mark by Opposer or its predecessors in interest. As such, Opposer’s rights in the LUBRIDERM Mark are prior and superior to any rights Applicant may claim in Applicant’s Mark. The registration of Applicant’s Mark is inconsistent with Opposer’s prior rights and statutory grant of exclusivity of use.

11. Applicant’s Mark is confusingly similar to Opposer’s prior used and registered LUBRIDERM Mark. The marks of the parties are confusingly similar in sight, sound, and commercial impressions; notably, LIBREDERM is highly similar to Opposer’s LUBRIDERM

Mark. Applicant's use and registration of the mark LIBREDERM in connection with the goods identified in its application is likely to cause confusion, cause mistake or to deceive consumers to falsely believe that Applicant's goods emanate from or otherwise are authorized, sponsored by, or affiliated with Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).


12. Moreover, Opposer's LUBRIDERM Mark is a famous mark for skin lotions and creams, and became so prior to July 10, 2015, the earliest date upon which Applicant can rely. Accordingly, Applicant's use and registration of Applicant's Mark will damage Opposer by trading on the enormous goodwill associated with the LUBRIDERM Mark and diluting its distinctiveness. Thus, Applicant's use and registration of LIBREDERM in connection with the goods identified in its applications is likely to cause dilution by blurring of Opposer's famous LUBRIDERM Mark, in violation of Sections 13(a) and 43(c) of the Lanham Act, 15 U.S.C. §§ 1063(a), 1125(c).

13. By reason of the foregoing, Opposer will be harmed by registration of Applicant's Mark.

WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration sought by Application Serial No. 79/176,138 be denied.

Dated: June 3, 2016
New York, New York

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

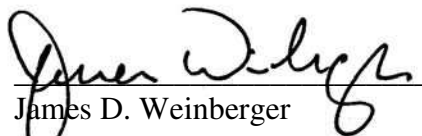
By: 
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Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that on June 3, 2016, a copy of the foregoing **NOTICE OF
OPPOSITION** was sent by first-class mail postage pre-paid to Applicant's Attorney of Record:

John H. Weber
Baker & Hostetler LLP
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Washington Square, Suite 1100
Washington, DC 20036-5304


James D. Weinberger